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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,885	09/19/2000	Richard Rubin	4138-A1	5127
29370	7590	02/24/2006	EXAMINER	
ROBERT A. PARSONS 4000 N. CENTRAL AVENUE, SUITE 1220 PHOENIX, AZ 85012			PASCUA, JES F	
			ART UNIT	PAPER NUMBER
			3727	

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/664,885  
Filing Date: September 19, 2000  
Appellant(s): RUBIN, RICHARD

**MAILED**

**FEB 24 2006**

**Group 3700**

\_\_\_\_\_  
Robert A. Parsons  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 01/05/2006 appealing from the Office action mailed 02/02/2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

**(9) Grounds of Rejection**

The following grounds of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,428,103 to Walsh.

Walsh discloses a container for keeping food warm comprising a pouch 10 formed of a plastic material 30, 36 to provide water impermeability, the pouch being constructed to define an insulated and substantially water impermeable food chamber. The chamber of the pouch is insulated with insulating material 34, which is superimposed with the plastic material 30, 36 and reflecting layer 32 to form an insulating structure. The pouch of Walsh further comprises opposing substantially coextensive lips 24 defining a passage for inserting food into the chamber of the pouch. Lips 24 include a closure 42 of complementary engagement elements.

Walsh discloses the claimed invention, especially the pouch including layers of water impermeable, plastic material 30, 36. However, it is unclear if the layers of plastic material are film and/or cloth. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use layers of film and/or cloth for the water impermeable, plastic material of Walsh, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 7, 13 and 20, Walsh discloses the claimed invention, as discussed above, except for the complementary engagement elements comprising hooks and loops instead of a zipper. It would have been obvious to one having ordinary

skill in the art at the time the invention was made to replace the zipper of Walsh with complementary hook and loop engagement elements since the Examiner takes Official Notice of the equivalence of hook and loop engagement elements and zippers for their use in the pouch art and the selection of any of these known equivalents to actively couple the lips 24 would be within the level of ordinary skill in the art.

Regarding the recitation “the lips formed to provide a passive, non-sealing engagement between the lips”, Walsh discloses the walls 16, 20 of the pouch being insulated by insulating material 34. Walsh further discloses that the insulating material 34 as being “soft, flexible and resilient”. See column 2, lines 36-40. The resilient nature of the insulating material 34 would cause the wall 12 to spring back into the position shown in Figs. 1, 2, 4 and 5 after being bent as shown in Fig. 3. Since lips 24 are connected to the walls 16, 20, the resilient nature of the insulating material 34 in the walls 16, 20 inherently cause the lips 24 to provide a “passive, non-sealing engagement between the lips” as claimed. Furthermore, until closure 42 is activated by a user to couple together lips 24; a “partial enclosure” of the chamber is provided.

Having demonstrated that the pouch of Walsh inherently forms a “partial enclosure caused by the passive, non-sealing engagement between the lips and the food warming chamber”, the function recitation “to inhibit a build-up of moisture vapor produced from warm food disposed in the warming chamber for preventing warm food disposed in the warming chamber from becoming soggy and to allow enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist” is met by Walsh. A recitation of the intended use of the

claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

**(10) Response to Argument**

Appellant's remarks that the reopening of prosecution after the Board decision is improper have been considered. It is brought to Appellant's attention that the Examiner's Director, E. Rollins-Cross, authorized the Office action of 08/25/2004 for the consideration of matters not already adjudicated. See 37 CFR 1.198. In this case, the matter that was not already adjudicated is the rejection of claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,428,103 to Walsh.

Appellant argues "there is a strong possibility that *res judicata* makes reopening prosecution improper, when the rejection is on the same cited prior art considered prior to winning the appeal". However, appellant has failed to indicate where the current grounds of rejection over the Walsh patent are based on a prior adjudication, against appellant on the same claim.

Regarding appellant's remark that "the Patent Office is basically attempting to 'invalidate' claims allowed by the Board of Appeals over the cited art", appellant is reminded that the Board of Appeals do not allow claims; otherwise their decision would have instructed the Examiner to issue appellant a Notice of Allowability.

Regarding appellant's remark that the water impermeability of the Walsh container "is not discussed by Walsh, and therefore, not taught by Walsh." Appellant's attention is directed to column 2, lines 30-33 of Walsh, which states, "Preferably, outer layer **30** and inner layer **36** should be flexible, waterproof, washable and durable. A suitable plastic material may be used." The "waterproof" characteristic of the layers 30, 36, disclosed by Walsh, meet appellant's recitation "a pouch including a layer formed of a film of plastic to provide water impermeability".

Regarding appellant's remark that "no lips are shown or described by Walsh", the front side 24 as shown in Figs. 1-5 of Walsh meets the recitation "lips" to the same degree appellant structurally sets forth in the claims.

In response to appellant's argument that "Nothing in Walsh even remotely suggest 'lips formed to provide a passive, non-sealing engagement between the lips'." a recitation of the intended use of the claimed invention must result in a structural difference between

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the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, functional recitation “to provide a passive, non-sealing engagement between the lips” fails to result in any *structural difference* between the “lips” of the claimed invention and the front side 24 of Walsh. As discussed in the grounds of rejection above, Walsh discloses the walls 16, 20 of the pouch being insulated by insulating material 34. Walsh further discloses that the insulating material 34 as being “soft, flexible and resilient”. See column 2, lines 36-40. The resilient nature of the insulating material 34 would cause the wall 12 to spring back into the position shown in Figs. 1, 2, 4 and 5 after being bent as shown in Fig. 3. Since lips 24 are connected to the walls 16, 20, the resilient nature of the insulating material 34 in the walls 16, 20 inherently cause the lips 24 to provide a “passive, non-sealing engagement between the lips” as claimed. Furthermore, until closure 42 is activated by a user to couple together lips 24; a “partial enclosure” of the chamber is provided.

#### **(11) Related Proceeding(s) Appendix**


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.



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Respectfully submitted,



Jes F. Pascua  
Primary Examiner

Conferees:



Nathan J. Newhouse, Supervisory Patent Examiner



Stephen K. Cronin, Primary Examiner